

## **V. REMARKS**

Claims 1-3 are rejected on the grounds of nonstatutory double patenting over claims 1-3 of Patent Number 6,937,298 to Okada. The rejection is respectfully traversed.

In determining double patenting, the issue is whether any claim of the application defines merely an obvious variation of an invention **claimed** in the earlier patent or application. It does not prohibit a later claiming of subject matter that is disclosed but not claimed in the earlier patent or application. Double patenting is concerned with attempts to "**claim**" related subject matter twice. In re Gibbs, 437 F.2d 486, 168 USPQ 578 (CCPA 1971).

Claims 1-3 of the 298 patent read as follows:

1. A gaming machine comprising: a liquid crystal display device including: a liquid crystal panel; and a light guiding plate in which formed with a light transmission area through which passes light and disposed at a rear of the liquid crystal panel, and configured to guide light emitted from illumination means for the liquid crystal panel to the liquid crystal panel; a variable display device disposed at a rear of the liquid crystal display device and opposing to the light transmission area, and including a plurality of reels provided in a row each on which a plurality of symbols are arranged; light emission means disposed in a proximity of the light transmission area on a side of the reel; a drive unit configured to drive the light emission means; and a protective member configured to cover the drive unit and at least a portion of the light emission means, the protective member having an outer shape that is separated from the drive unit at at least a predetermined distance.

2. The gaming machine as claimed in claim 1, wherein the protective

member is formed in a shape to diffuse the light emitted by the light emission part.

3. The gaming machine as claimed in claim 1, wherein the protective member is formed of a material that diffuses the light emitted by the light emission part.

Claims 1 and 2 of the present invention read as follows:

1. A gaming machine comprising: a liquid crystal display device including a liquid crystal panel, and a light guiding plate disposed at a rear of the liquid crystal panel for guiding light emitted from illumination means for the liquid crystal panel to the liquid crystal panel; and a variable display device disposed at a rear of the liquid crystal display device and including a plurality of reels provided in a row each on which a plurality of symbols are arranged, wherein a part of the light guiding plate to which each of the reels is opposed is formed with a cutout or a recess on the side opposed to the reel, and wherein an end face of the cutout or the recess is being applied with a light scattering process.

2. A gaming machine comprising: a liquid crystal display device including a liquid crystal panel, and a light guiding plate disposed at a rear of the liquid crystal panel for guiding light emitted from an illumination means for the liquid crystal panel to the liquid crystal panel; and a variable display device disposed at a rear of the liquid crystal display device and including a plurality of reels provided in a row each on which a plurality of symbols are arranged, wherein a part of the light guiding plate to which each of the reels is opposed is formed with a cutout or a recess on the side opposed to the reel, and wherein an end face of the cutout or the recess is formed in a shape to scatter light.

3. The gaming machine as claimed in claim 1, wherein a part of at least one of the plurality of reels is inserted into the cutout or the recess.

As admitted by the United States Patent and Trademark Office, the limitations describing a cutout in the liquid crystal display and the application of light to an end face of the cutout is not explicitly claimed by Okada. Thus, it is respectfully submitted that the rejection must be withdrawn because claim 1 of the present application does not claim related subject matter twice in that the 298 patent fails to claim the limitations describing the cutout and the application of light to the end face thereof. Also, it is respectfully submitted that the rejection must be withdrawn because claim 2 of the present application does not claim related subject matter twice in that the 298 patent fails to claim that an end face of the cutout or the recess is formed in a shape to scatter light. Further, it is respectfully submitted that the rejection must be withdrawn because claim 3 of the present application does not claim related subject matter twice in that the 298 patent fails to claim a part of at least one of the plurality of reels is inserted into the cutout or the recess.

At a minimum, claims 1, 2 and 3 of the present application are claiming subject matter that might be disclosed but are not claimed in the earlier patent. Later claiming of subject matter that is disclosed but not claimed in the earlier patent is permissible under the rules of practice without violating the rule of nonstatutory double patenting.

The Examiner must establish a *prima facie* case of obviousness-type double-patenting or the rejection, if applied, will be reversed by the Board of Patent Appeals. The Examiner is obligated to clearly set forth the basis of an obviousness-type double-patenting rejection. Under MPEP 804 II. B. 1., it states:

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined in the **conflicting claims**--a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the **invention defined in the claim in issue** is an obvious variation of the **invention defined in a claim in the patent**.

It is respectfully submitted that the rejection is also improper because the Examiner fails to make clear the obviousness-type double patenting rejection, particularly subparagraphs (A) and (B) above. As a result, in our opinion, the Examiner fails to establish a *prima facie* case of obviousness-type double patenting.

Withdrawal of the rejection is respectfully requested.

Claims 4-9 are added to the application.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested. Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

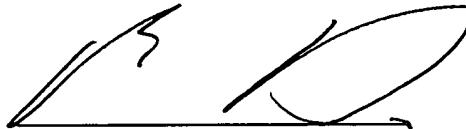
Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of

the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

Respectfully submitted,

Date: January 3, 2007

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Enclosure(s):          Amendment Transmittal

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